



[3510-16-P]

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

[Docket No.: PTO-P-2015-0062]

Streamlined, Expedited Patent Appeal Pilot for Small Entities

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Notice.

SUMMARY: The United States Patent and Trademark Office (USPTO) has a procedure under which an application will be advanced out of turn (accorded special status) for examination if the applicant files a petition to make special with the appropriate showing. The USPTO is providing a temporary basis (the Streamlined, Expedited Patent Appeal Pilot for Small Entities) under which a small or micro entity appellant may have an ex parte appeal to the Patent Trial and Appeal Board (Board) accorded special status if the appellant has only a single appeal pending before the Board and the appellant agrees to streamline the appeal. Specifically, the appeal must not involve any claim subject to a rejection for lack of written description, enablement, or best mode, or for indefiniteness, and the appellant must agree to the disposition of all claims subject to each ground of rejection as a single group and waive any request for an oral hearing. The Streamlined, Expedited Patent Appeal Pilot for Small Entities will allow small or micro entity appellants who streamline their appeals to have greater control over the priority with

which their appeals are decided.

DATES: EFFECTIVE DATE: September 18, 2015.

DURATION: The Streamlined, Expedited Patent Appeal Pilot for Small Entities is being adopted on a temporary basis and will run until two thousand (2,000) appeals have been accorded special status under the pilot, or until September 16, 2016, whichever occurs earlier. The USPTO may extend the Streamlined, Expedited Patent Appeal Pilot for Small Entities (with or without modification) on either a temporary or permanent basis, or may discontinue this pilot after September 16, 2016, depending upon the results.

FOR FURTHER INFORMATION CONTACT: Steven Bartlett, Patent Trial and Appeal Board, by telephone at 571-272-9797, or by electronic mail message at expeditedpatentappealspilot@uspto.gov.

SUPPLEMENTARY INFORMATION: Appeals to the Board are normally taken up for decision by the Board in the order in which they are docketed. The USPTO has a preexisting procedure under which an application will be advanced out of turn (accorded special status) if the applicant files a petition to make special with the appropriate showing. See 37 CFR 1.102 and MPEP section 708.02. The USPTO recently adopted the Expedited Patent Appeal Pilot, under which an appellant may have an ex parte appeal to the Board in an application accorded special status if the appellant withdraws the

appeal in another application or ex parte reexamination with an ex parte appeal also pending before the Board. See Expedited Patent Appeal Pilot, 80 FR 34145 (June 15, 2015). The USPTO is now adopting, on a temporary basis, the Streamlined, Expedited Patent Appeal Pilot for Small Entities, under which a small or micro entity appellant may have an ex parte appeal to the Board accorded special status if the appellant has only a single appeal pending before the Board as of September 18, 2015 and the appellant agrees to streamline the appeal. The Streamlined, Expedited Patent Appeal Pilot for Small Entities will permit small or micro entity appellants to accelerate the Board decision on an appeal, possibly hastening the pace at which the invention is patented and brought to the marketplace, and thus spurring follow-on innovation, economic growth, and job creation. The streamlining of appeals under this pilot also will assist the Board to more efficiently reduce the overall inventory of pending appeals.

The USPTO will accord special status to an appeal pending before the Board under the Streamlined, Expedited Patent Appeal Pilot for Small Entities under the following conditions:

(1) A certification and petition under 37 CFR 41.3 must be filed by the USPTO's electronic filing system (EFS-Web) in the application involved in the ex parte appeal for which special status is sought ("appeal to be made special"), identifying that application and appeal by application and appeal number, respectively. In addition, the appeal to be made special must be the appellant's only appeal pending before the Board as of

September 18, 2015, and the appeal to be made special must have been docketed with the PTAB on or before September 18, 2015.

(2) The appellant must certify that the appellant has established status as a small entity or micro entity in the application underlying the appeal to be made special and also must certify that status as a small entity or micro entity is still appropriate. See 37 CFR 1.27 and 1.28 concerning small entity status and see 37 CFR 1.29 concerning micro entity status.

(3) The appellant must agree that, for each ground of rejection applying to two or more claims, the PTAB may select a single claim from the claims subject to each ground of rejection and decide the appeal to be made special with respect to every claim subject to that ground of rejection on the basis of the selected claim alone. See 37 CFR 41.37(c)(1)(iv) concerning the treatment of claims subject to the same ground of rejection argued together as a group.

(4) The appellant must certify that the appeal to be made special does not involve any claim subject to a rejection under 35 U.S.C. 112. If an appeal made special under the Streamlined, Expedited Patent Appeal Pilot for Small Entities is found to involve one or more claims subject to a rejection under 35 U.S.C. 112, the appeal normally will be removed from the pilot at the discretion of the Board.

(5) The appellant must agree to waive any oral hearing in the appeal to be made special, and acknowledge that any oral hearing fees paid in connection with the appeal to be made special will not be refunded.

(6) The petition under 37 CFR 41.3 must be signed by a registered practitioner who has a power of attorney under 37 CFR 1.32, or has authority to act under 37 CFR 1.34, for the application involved in the appeal to be made special.

The USPTO has created a form-fillable Portable Document Format (PDF) “Petition to Make Special – the Streamlined, Expedited Patent Appeal Pilot for Small Entities” (Form PTO/SB/441) for use in filing a certification and petition under 37 CFR 41.3 under the Streamlined, Expedited Patent Appeal Pilot for Small Entities. Form PTO/SB/441 is available on the USPTO’s Internet Web site on the micro site for USPTO patent-related forms (<http://www.uspto.gov/patent/patents-forms>). Form PTO/SB/441 does not collect “information” within the meaning of the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*). *See* 5 CFR 1320.3(h). Therefore, this notice does not involve information collection requirements which are subject to review by OMB.

No petition fee is required. The \$400.00 fee for a petition under 37 CFR 41.3 is hereby sua sponte waived for any petition to make an appeal special under the Streamlined, Expedited Patent Appeal Pilot for Small Entities.

MPEP section 1203 provides that an application made special and advanced out of turn for examination will continue to be special throughout its entire course of prosecution in the Office, including appeal, if any, to the Board. An appeal that is accorded special status for decision on an appeal to the Board under the Streamlined, Expedited Patent

Appeal Pilot for Small Entities will be advanced out of turn for a decision on the appeal by the Board. The difference between the Streamlined, Expedited Patent Appeal Pilot for Small Entities and an application made special under 37 CFR 1.102 and MPEP section 708.02 is that an application in which an appeal is accorded special status for decision on an appeal to the Board under the Streamlined, Expedited Patent Appeal Pilot for Small Entities will not have a special status under CFR 1.102 and MPEP section 708.02 after the decision on the appeal.

The goal for handling an application in which a petition to make an appeal special under the Streamlined, Expedited Patent Appeal Pilot for Small Entities is filed is as follows:

(1) rendering a decision on the petition to make the appeal special no later than two months from the filing date of the petition; and (2) rendering a decision on the appeal no later than four months from the date a petition to make an appeal special under the Streamlined, Expedited Patent Appeal Pilot for Small Entities is granted. The current pendency of decided appeals in applications, for those appeals decided this fiscal year, ranges between an average of 24.9 months for appeals from applications assigned to Technology Center 1700 and an average of 32.5 months for appeals from applications assigned to Technology Center 1600, and is shown for each Technology Center in the following table:

Technology Center	Average Months From Docketing Notice to Board Decision
1600	32.5

1700	24.9
2100	31.6
2400	31.2
2600	31.2
2800	27.0
2900	26.2
3600	31.7
3700	30.1

Ex parte reexamination proceedings, including any appeal to the Board, are conducted with special dispatch within the USPTO. See 35 U.S.C. 305. The current average pendency of appeals in ex parte reexaminations, for those appeals decided this fiscal year, is 6.0 months. The USPTO is not making the Streamlined, Expedited Patent Appeal Pilot for Small Entities applicable to appeals in ex parte reexaminations as these appeals already are handled with special dispatch, and the petition evaluation process only would delay the Board decision in an appeal in an ex parte reexamination.

The Streamlined, Expedited Patent Appeal Pilot for Small Entities is being adopted on a temporary basis until two thousand (2,000) appeals have been accorded special status under the pilot, or until September 16, 2016, whichever occurs earlier. The USPTO may extend the Streamlined, Expedited Patent Appeal Pilot for Small Entities (with or without modification) on either a temporary or permanent basis, or may discontinue the pilot after September 16, 2016, depending upon the results. Additional information concerning the Streamlined, Expedited Patent Appeal Pilot for Small Entities, including statistical

information and pendency of appeals before the Board, can found on the USPTO Internet

Web site at:

<https://www-cms.uspto.gov/patents-application-process/patent-trial-and-appeal-board/expedited-patent-appeal-pilot>.

Dated: September 8, 2015.

Michelle K. Lee

Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

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